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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,486	11/27/2001	Shinichi Watanabe	P20705	8162
7055 7590 01/14/2008 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			EXAMINER KOROBOV, VITALI A	
			ART UNIT 2155	PAPER NUMBER
			NOTIFICATION DATE 01/14/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
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# Office Action Summary

Application No.

09/993,486

Applicant(s)

WATANABE ET AL.

Examiner

Vitali Korobov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 12-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **RESPONSE TO RCE**

1. This Office Action is in response to an RCE filed on 09/21/2007. Claims 12, 16 and 17 have been amended. Claims 12-18 are currently pending and have been examined in this Office Action.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous office action has been withdrawn pursuant to 37 CFR 1.114. The Applicant's submission filed on 09/21/2007 has been entered.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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3. Claims 12 and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by the U. S. Patent No. 6,438,217, issued to Huna, hereinafter Huna.

Regarding claim 12, Huna teaches a server apparatus (Fig. 4, the message server 402) connected to a transmitting IP apparatus, the transmitting IP apparatus (Fig. 5, IP apparatus 504) transmitting an e-mail (Fig. 5, box 506) to a receiving IP apparatus (Fig. 5, fax 524, PC 532, etc.) via the server apparatus (Fig. 4, servers 402 and 404), the server apparatus comprising: a memory configured to store an IP address of the receiving IP apparatus in association with a telephone number of the receiving IP apparatus (15:13-21 and 15:46-48 - address book is stored in the memory of the server, and allows transmission of messages directly to the IP address of the recipient), the IP address of the receiving IP apparatus being distinct from an e-mail address (Fig. 7, "To:" field, indicating Richard's telephone number, which is distinct from Richard's IP Address. As per 15:46-48, the message is transmitted directly to Richard's IP address); a receiver configured to receive the e-mail from the transmitting IP apparatus (16:20-31 - message server 512 receives e-mails. User 502 sends message 508 in e-mail format, and IP apparatuses of Joe, Jim and Julie receive it), the e-mail including the telephone number of the receiving IP apparatus (Fig. 7, "To:" field, indicating Richard's telephone number); an analyzer configured to obtain, from the received e-mail, the telephone number of the receiving IP apparatus, and to obtain, from the memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, the receiving IP apparatus of the IP address, being the same as the

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receiving IP apparatus of the telephone number (Fig. 7, "To:" field, indicating Richard's telephone number, which is distinct from Richard's IP Address. As per 15:46-48, the message is transmitted directly to Richard's IP address); and a transmitter configured to transmit the received e-mail to the receiving IP apparatus, based on the IP address of the receiving IP apparatus (As per 15:46-48, the message is transmitted directly to Richard's IP address).

Regarding claim 15, Huna teaches the server apparatus according to claim 12, wherein a header of the e-mail from the transmitting IP apparatus includes the telephone number of the receiving IP apparatus (Fig. 7, "To:" field, indicating Richard's telephone number, which is distinct from Richard's IP Address).

Claim 16 is rejected in view of the above rejection of claim 12. Claim 16 is essentially the same as claim 12, except that it sets forth the invention as a system rather than a server apparatus, as does claim 12.

Claim 17 is rejected in view of the above rejection of claim 12. Claim 17 is essentially the same as claim 12, except that it sets forth the invention as a method rather than a server apparatus, as does claim 12.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be

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patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huna in view of the U.S. Patent 6,748,057 to Ranalli et al., hereinafter Ranalli.

Regarding claim 13, Huna teaches the server apparatus according to claim 12.

Huna does not explicitly teach the server apparatus wherein the transmitter transmits an error message to the transmitting IP apparatus when the memory does not store the IP address of the receiving IP apparatus in association with the telephone number of the receiving IP apparatus.

However, Ranalli in analogous art, related to directory service for enabling communications over a data network such as the Internet, and more particularly to the use of a unique identifier (for example, a telephone number) with this directory as a

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means for acquiring the associated data network address information for an intended recipient of a communication, teaches industry standard mail transmission protocol, and transmission of an error message to the transmitting IP apparatus when the memory does not store the IP address of the receiving IP apparatus in association with the telephone number of the receiving IP apparatus. (See Ranalli, col. 5, lines 9-12, where Ranalli teaches the use of SMTP protocol as one possible mode of implementation. The industry standard implementation of SMTP (according to RFC 821, August 13, 1982) provides for error notification if the recipient is not registered (Reply Code 550)).

Therefore, it would have been obvious to one having ordinary skills in the art at the time the invention was made to incorporate the teachings of Ranalli regarding implementation of industry standard SMTP protocol for e-mail transmission into the teachings of Huna in order to simplify transfer of electronic mail and to implement other convenient features SMTP provides. Huna with incorporated teachings of Ranalli is hereinafter referred to as Huna/Ranalli.

Regarding claim 18, Huna/Ranalli teaches the server apparatus according to claim 12, wherein the transmitter transmits the received e-mail to the receiving IP apparatus, based on the IP address of the receiving IP apparatus, in accordance with a SMTP protocol (See Ranalli, col. 5, lines 9-12, where Ranalli teaches the use of SMTP protocol as one possible mode of implementation, and col. 5, lines 50-55, where Ranalli teaches conversion of an e-mail address in a telephone number format into the IP address of the receiving IP apparatus).

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6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huna in view of the U.S. Patent 6,735,617 to Goodman (hereinafter Goodman).

Regarding claim 14, Huna teaches the server apparatus according to claim 12, but fails to explicitly teach such server being connected to a H.323 gatekeeper, the H.323 gatekeeper storing the IP address of the receiving IP apparatus in association with the telephone number of the receiving IP apparatus, the analyzer being configured to determine whether the memory stores the IP address of to the receiving IP apparatus, and when it is determined that the memory does not store the IP address of the receiving IP apparatus, the transmitter accesses the H.323 gatekeeper to obtain the IP address of the receiving IP apparatus.

However, Goodman in analogous art, related to transmission of e-mail, i.e. facsimile copies of documents over H.323 network, teaches a server that is being connected to a H.323 gatekeeper, the H.323 gatekeeper storing the IP address of the receiving IP apparatus in association with the telephone number of the receiving IP apparatus (Goodman, Fig. 10, sender's mail server 950, and the outbound H.323 gateway 965. See also col. 4, lines 6-7, where Goodman teaches an H.323 gatekeeper's function of finding an IP address for a gateway associated with a telephone number), the analyzer being configured to determine whether the memory stores the IP address of the receiving IP apparatus (See col. 4, lines 6-7, where Goodman teaches an H.323 gatekeeper's function of finding an IP address for a gateway associated with a telephone number), and when it is determined that the



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memory does not store the IP address of the receiving IP apparatus, the transmitter accesses the H.323 gatekeeper to obtain the IP address of the receiving IP apparatus (See col. 4, lines 65-67, where Goodman teaches that the "IP address – telephone number" look-up table may be maintained at the facsimile mail server or at the H.323 Gatekeeper).

Therefore, it would have been obvious to one having ordinary skills in the art at the time the invention was made to combine the alternative locations for a look-up table taught by Goodman with the teachings of Huna in order to take advantage of special records designating which IP addresses are mail servers and make cross-service connectivity in telecommunications network even more seamless and efficient (See col. 3, lines 62-67 and col. 4, lines 1-8 of Goodman).

7. **Examiner's note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 12-18 have been considered but are moot in view of the new ground(s) of rejection, necessitated by the Applicant's amendment.

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**Conclusion**

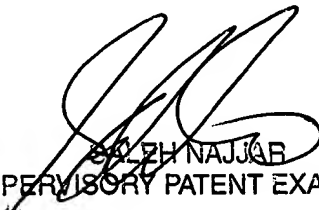
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must show how the amendments avoid such references and objections. See 37 CFR § 1.111(c).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vitali Korobov whose telephone number is 571-272-7506. The examiner can normally be reached on Mon-Friday 8a.m. - 4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571)272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

01/07/2008  
VAK

  
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SUPERVISORY PATENT EXAMINER

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Examiner, Art Unit 2155